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09/858,360	05/16/2001	Joseph A. Manico	82171SLP	3327

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EXAMINER

BAKER, CHARLOTTE M

ART UNIT PAPER NUMBER

2626

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/858,360

Applicant(s)

MANICO ET AL.

Examiner

Charlotte M Baker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/16/2001</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No. 09/859033 (hereinafter referred to as '033). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The preamble of claim 1 of '360 refers to a method of dispensing, whereas claim 1 of '033 refers to a method of remotely purchasing.

Regarding claim 1: Claim 1 steps a-f of 09/858360 (hereinafter referred to as '360) correspond to claim 1 steps a-d, and f-g of '033, which is broader because it does not define "generating an identifier for an image".

Regarding claim 2: Claim 2 of '360 corresponds to claim 1 step g of '033.

Regarding claims 3 and 4: Claims 3 and 4 of '360 correspond to claim 15 of '033.

Regarding claim 5: Claim 5 of '360 corresponds to claim 16 of '033.

Regarding claim 9: Claim 9 of '360 corresponds to claim 9 of '033.

Regarding claim 11: Claim 11 of '360 corresponds to claim 10 of '033.

Regarding claims 12 and 13: Claims 12 and 13 of '360 correspond to claim 11 of '033.

The preamble of claim 14 of '360 refers to a method of dispensing image bearing products, whereas claim 18 of '033 refers to a method of notifying a recipient of the availability of an image bearing product.

Regarding claims 14 and 15: Claim 14 of '360 corresponds to claim 18 steps a-d and f-g of '033. Claim 14 step a of '360 is broader than claim 18 step a of '033 because it does not include the "point of sale capability". Claim 14 step c of '360 is broader than claim 18 step f because the notification to the recipient is done "after payment has been provided". Claim 14 step d of '360 is narrower than claim 18 step c because "the recipient" inputs an image. Claim 15 of '360 corresponds to claim 18 step h of '033.

Regarding claims 16 and 17: Claims 16 and 17 of '360 correspond to claim 19 of '033.

Regarding claim 18: Claim 18 of '360 corresponds to claim 20 of '033.

Regarding claim 22: Claim 22 of '360 corresponds to claim 22 of '033.

Regarding claim 23: Claim 23 of '360 corresponds to claim 24 of '033.

Regarding claims 24 and 25: Claims 24 and 25 correspond to claim 25 of '033.

These limitations are obvious variations of its respective claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7, 9-20, and 22-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Redd et al. (6,646,754).

Regarding claim 1: Redd et al. disclose providing a plurality of network connected kiosks

(kiosks in communication with the photo-finisher's host system over a network, col. 13, ln. 9-21) having image input (scanner, col. 13, ln. 42) and product output (displayed on a monitor, col. 13, ln. 29-30) capability; inputting an image at one of the plurality of network connected kiosks (scanner, col. 13, ln. 42); generating an identifier for the image (Figure 7, web address 908 and col. 13, ln. 53-61); storing the image at a network accessible location (image archive database 330 and col. 13, ln. 62-66); providing a recipient with the identifier (Figure 7, web address 908) and using the identifier to retrieve the image (access the website, col. 13, ln. 58-61).

Regarding claim 2: Redd et al. satisfy all the elements of claim 1. Redd et al. further disclose using the retrieved image to generate the image bearing product at any one of the plurality of networked connected kiosks (kiosks in communication with the photo-finisher's host system over a network col. 13, ln. 58-61).

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Regarding claim 3: Redd et al. satisfy all the elements of claim 1. Redd et al. further disclose providing a printer (print lab system 340 and col. 13, ln. 16-21); inputting a name and address of the recipient at one of the plurality of networked connected kiosks (Figure 7, address field 906 and col. 10, ln.56-60 and col. 13, ln. 33); printing a postcard with the printer comprising the name and address of the recipient and the identifier sending the postcard to the recipient (destination identifier print 900, Figure 7).

Regarding claim 4: Redd et al. satisfy all the elements of claim 3. Redd et al. further disclose wherein the printer is network connected (print lab system 340, printer is remotely located at the host facility, which is part of the network, col. 13, ln. 16-21).

Regarding claim 5: Redd et al. satisfy all the elements of claim 3. Redd et al. further disclose the step of reading the identifier from the postcard (using a bar code reader, col. 18, ln. 24-27).

Regarding claim 6: Redd et al satisfy all the elements of claim 1. Redd et al. further disclose wherein the step of providing the recipient with the identifier comprises sending a postcard (destination identifier print 900, Figure 7).

Regarding claim 7: Redd et al. satisfy all the elements of claim 1. Redd et al. further disclose wherein the step of providing a recipient with the identifier comprises sending an e-mail (the network is inherently capable of electronic mail and the person who placed the order can provide as the recipient's address an e-mail address).

Regarding claim 9: Redd et al. satisfy all the elements of claim 1. Redd et al. further disclose the step of sending a thank you message (Figure 8, user specified message 934, col. 18, ln. 7-10).

Regarding claim 10: Redd et al. satisfy all the elements of claim 1. Redd et al. further disclose a networked home computer (col. 12, ln. 29-38).

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Regarding claim 11: Redd et al. satisfy all the elements of claim 1. Redd et al. further disclose wherein the image is retrieved at any of the plurality of network connected kiosks (access the website via the reordering information 908 and col. 13, ln. 58-61).

Regarding claim 12: Redd et al. satisfy all the elements of claim 1. Redd et al. further disclose wherein the image is stored at a network accessible location identified by the identifier (Figure 7, reordering information 908 and col. 14, ln. 26-30).

Regarding claim 13: Redd et al. satisfy all the elements of claim 12. Redd et al. further disclose wherein the image is retrieved from the network accessible location identified by the identifier (Figure 7, reordering information 908 and col. 14, ln. 26-30).

Regarding claim 14: Arguments analogous to those stated in the rejection of claim 1 are applicable. It is an inherent feature of the network connected kiosks that a recipient would have the capability of also inputting an image upon accessing using an identifier.

Regarding claim 15: Redd et al. satisfy all the elements of claim 14. Arguments analogous to those stated in the rejection of claim 2 are applicable.

Regarding claim 16: Redd et al. satisfy all the elements of claim 14. Arguments analogous to those stated in the rejection of claim 3 are applicable.

Regarding claim 17: Redd et al. satisfy all the elements of claim 16. Arguments analogous to those stated in the rejection of claim 4 are applicable.

Regarding claim 18: Redd et al. satisfy all the elements of claim 16. Arguments analogous to those stated in the rejection of claim 5 are applicable.

Regarding claim 19: Redd et al. satisfy all the elements of claim 14. Arguments analogous to those stated in the rejection of claim 6 are applicable.

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Regarding claim 20: Redd et al. satisfy all the elements of claim 14. Arguments analogous to those stated in the rejection of claim 7 are applicable.

Regarding claim 22: Redd et al. satisfy all the elements of claim 14. Arguments analogous to those stated in the rejection of claim 9 are applicable.

Regarding claim 23: Redd et al. satisfy all the elements of claim 14. Arguments analogous to those stated in the rejection of claim 11 are applicable.

Regarding claim 24: Redd et al. satisfy all the elements of claim 14. Arguments analogous to those stated in the rejection of claim 13 are applicable.

Regarding claim 25: Redd et al. satisfy all the elements of claim 14. Arguments analogous to those stated in the rejection of claim 12 are applicable.

Regarding claim 26: Arguments analogous to those stated in the rejections of claims 1, 14, 15, and 16 are applicable.

Regarding claim 27: Redd et al. satisfy all the elements of claim 26. Arguments analogous to those stated in the rejections of claims 4 and 17 are applicable.

Regarding claim 28: Redd et al. satisfy all the elements of claim 26. Arguments analogous to those stated in the rejections of claims 9 and 22 are applicable.

Regarding claim 29: Redd et al. satisfy all the elements of claim 26. Arguments analogous to those stated in the rejection of claim 10 are applicable.

Regarding claim 30: Redd et al. satisfy all the elements of claim 26. Arguments analogous to those stated in the rejections of claims 11 and 15 are applicable.

Regarding claim 31: Redd et al. satisfy all the elements of claim 26. Arguments analogous to those stated in the rejections of claims 13 and 24 are applicable.

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Regarding claim 32: Arguments analogous to those stated in the rejections of claims 14-16 are applicable. A “first” and “second” “recipient and postcard” are addressed by the applicant in claim 32. Redd et al. disclose the capability of multiple recipients (col. 11, ln. 18-37). Redd et al. further disclose printing a second postcard with the printer comprising a name and address of a second recipient and the identifier (Figure 7 and col. 17, ln. 12-39); sending the second postcard to the second recipient (Figure 7 destination identifier print 900); the second recipient using the identifier to retrieve the image (Figure 8 unique identification number 922 and col. 17, ln. 65-67 through col. 18, ln. 1-7).

Regarding claim 33: Redd et al. satisfy all the elements of claim 32. Arguments analogous to those stated in the rejections of claims 4, 17, and 27 are applicable.

Regarding claim 34: Redd et al. satisfy all the elements of claim 32. Arguments analogous to those stated in the rejections of claims 9, 22, and 28 are applicable.

Regarding claim 35: Redd et al. satisfy all the elements of claim 32. Arguments analogous to those stated in the rejections of claims 9, 22, 28, and 34 are applicable.

Regarding claim 36: Redd et al. satisfy all the elements of claim 32. Arguments analogous to those stated in the rejections of claims 11, 15, and 30 are applicable.

Regarding claim 37: Redd et al. satisfy all the elements of claim 32. Arguments analogous to those stated in the rejections of claims 12 and 25 are applicable.

Regarding claim 38: Redd et al. satisfy all the elements of claim 37. Arguments analogous to those stated in the rejections of claims 13, 24, and 31 are applicable.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Redd et al. in view of Liebenow (US 2002/0085840 A1).

Regarding claim 8: Redd et al. satisfy all the elements of claim 1.

Redd et al. fail to specifically address sending a telephonic message.

Liebenow discloses sending a telephonic message (pre-recorded message, p. 4, par. 31).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include sending a telephonic message to a recipient as taught by Liebenow to communicate an identifier for the images so that the customer does not have to wait an extended period of time to view the prints.

Regarding claim 21: Redd et al. satisfy all the elements of claim 14. Arguments analogous to those stated in the rejection of claim 8 are applicable.

Conclusion

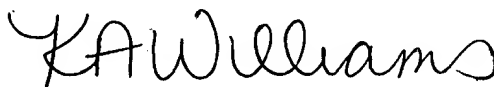
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlotte M Baker whose telephone number is (703) 306-3456. The examiner can normally be reached on Monday-Friday 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


cmb



**KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER**